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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,416	03/01/2002	Donald J. Munsil	MSFT118149	6209
26389	7590	11/16/2006	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			ROCHE, TRENTON J	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/090,416	MUNSIL ET AL.
	Examiner	Art Unit
	Trenton J. Roche	2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 October 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-79 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-79 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 March 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This office action is responsive to communications filed 25 September 2006.
2. Claims 1-79 are currently pending and have been examined.

Requirement for Information

3. In view of Applicants' remarks submitted 26 June 2006, the Requirement for Information under 37 CFR § 1.105 has been withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 13, 26, 34, 42, 47, 50, 55, 58, 61, 64 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by "Windows 'Whistler' Beta 1 reviewed" by Thurrott (hereinafter "Thurrott").**

Per claim 1:

Thurrott discloses:

- receiving a request to launch an application ("applications that expect to be running..." on page 4)

- determining if there is a custom database for said requesting application, wherein said custom database includes an operating system provided compatibility fix (“Whistler maintains a database that will automatically fool many applications into working. But if the application isn’t in that database—which will be updated over time from the Windows Update Web site...” on page 4.)
- if there is a custom database for said requested application, adding said compatibility fix in said custom database to a list of compatibility fixes for said requested application (“Whistler maintains a database that will automatically fool many applications into working. But if the application isn’t in that database—which will be updated over time from the Windows Update Web site...” on page 4.)
- applying said compatibility fixes on said list to said requested application (“Whistler maintains a database that will automatically fool many applications into working. But if the application isn’t in that database—which will be updated over time from the Windows Update Web site...” on page 4. If the application exists in the database, Whistler applies the emulation mode.)
substantially as claimed.

Per claim 26:

Thurrott discloses:

- identifying an application to be fixed (“applications that expect to be running...” on page 4)
- selecting an operating system provided compatibility fix (“you can simply right-click any application...and choose the ‘Run in emulation mode’ option, and then choose ‘Windows 95’...” on page 4.)

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- storing said selected compatibility fix in a custom database for said application (“Whistler maintains a database that will automatically fool many applications into working. But if the application isn’t in that database—which will be updated over time from the Windows Update Web site...” on page 4.) substantially as claimed.

Per claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73:

6. The rejection of claims 1 and 26 is incorporated, and further, claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73 recite substantially similar limitations from claims 1 and 26 and are therefore rejected under the same rationale.

7. **Claims 1, 13, 26, 34, 42, 47, 50, 55, 58, 61, 64 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by “Introducing Whistler” by Schifreen (hereinafter “Schifreen”).**

Per claim 1:

Schifreen discloses:

- receiving a request to launch an application (“the application reports that “This application requires Windows 95 or greater.”” On page 5. As the application already attempted to run, the request to launch was already received.)

- determining if there is a custom database for said requesting application, wherein said custom database includes an operating system provided compatibility fix (“A database of applications, problems and fixes...this database is updated from the Web via Auto Update.” on page 5)

- if there is a custom database for said requested application, adding said compatibility fix in said custom database to a list of compatibility fixes for said requested application (“A database of applications, problems and fixes...this database is updated from the Web via Auto Update.” on page 5. The updating would add an additional fix to the database.)
- applying said compatibility fixes on said list to said requested application (“the end-user can enable a compatibility mode for custom-built applications” on page 5.)

substantially as claimed.

Per claim 26:

Schifreen discloses:

- identifying an application to be fixed (“the application reports that ‘This application requires Windows 95 or greater.’” On page 5.)
- selecting an operating system provided compatibility fix (“The user can select ‘Run in Windows 95 compatibility mode’ on the application property sheet, relaunch the application and start using it” on page 5)
- storing said selected compatibility fix in a custom database for said application (“A database of applications, problems and fixes...this database is updated from the Web via Auto Update.” on page 5. The updating would store the additional fix in the database.)

substantially as claimed.

Per claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73:

The rejection of claims 1 and 26 is incorporated, and further, claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73 recite substantially similar limitations from claims 1 and 26 and are therefore rejected under the same rationale.

8. Claims 1, 13, 26, 34, 42, 47, 50, 55, 58, 61, 64 and 73 are rejected under 35 U.S.C. 102(a) as being anticipated by “Windows XP Technical Overview” by Microsoft Corporation (hereinafter “Microsoft”).

Per claim 1:

Microsoft discloses:

- receiving a request to launch an application (“when applications incorrectly detect the operating system version...” on page 16. The program is running, and as such, a request to launch the program would have been received.)
- determining if there is a custom database for said requesting application, wherein said custom database includes an operating system provided compatibility fix (“Fixes are invoked automatically by the operating system to make otherwise incompatible applications functions...as new applications appear or new fixes become available, application updates can be downloaded automatically from the Windows Update Web site...” Further, Note Figure 8.)
- if there is a custom database for said requested application, adding said compatibility fix in said custom database to a list of compatibility fixes for said requested application (“Fixes are invoked automatically by the operating system to make otherwise incompatible applications functions...as new applications appear or new fixes become available, application updates

can be downloaded automatically from the Windows Update Web site...” Further, Note Figure 8.)

- applying said compatibility fixes on said list to said requested application (“Fixes are invoked automatically by the operating system to make otherwise incompatible applications function...” on page 16)

substantially as claimed.

Per claim 26:

Microsoft discloses:

- identifying an application to be fixed (“when applications incorrectly detect the operating system version...” on page 16. The program is running, and as such, a request to launch the program would have been received.)
- selecting an operating system provided compatibility fix (Note Figure 8)
- storing said selected compatibility fix in a custom database for said application (“Fixes are invoked automatically by the operating system to make otherwise incompatible applications functions...as new applications appear or new fixes become available, application updates can be downloaded automatically from the Windows Update Web site...” Further, Note Figure 8.)

substantially as claimed.

Per claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73:

The rejection of claims 1 and 26 is incorporated, and further, claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73 recite substantially similar limitations from claims 1 and 26 and are therefore rejected under the same rationale.

9. Claims 1-79 are rejected under 35 U.S.C. 102(a) as being anticipated by "Windows XP Application Compatibility Technologies" by Morehouse et al. (hereinafter "Article").

Per claim 1:

Article discloses:

- receiving a request to launch an application ("When matching information determines that the user is about to run an incompatible application..." on page 4)
- determining if there is a custom database for said requesting application, wherein said custom database includes an operating system provided compatibility fix ("Windows Article can...invoke a compatibility fix..." on page 4. Further, the database of compatibility fixes included with the operating system..." on page 9)
- if there is a custom database for said requested application, adding said compatibility fix in said custom database to a list of compatibility fixes for said requested application ("the group of fixes being used" on page 11)
- applying said compatibility fixes on said list to said requested application ("apply custom compatibility fixes to applications..." on page 13)

substantially as claimed.

Per claim 26:

Article discloses:

- identifying an application to be fixed (“selecting the application from a list of applications with known problems...” on page 8)
- selecting an operating system provided compatibility fix (“apply one or more of the numerous fixes available...” on page 11)
- storing said selected compatibility fix in a custom database for said application (“creating and maintaining custom compatibility databases...add to or more from your custom database any specific fixes...” on page 11. Further, note Figures 6 and 7)

substantially as claimed.

Per claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73:

The rejection of claims 1 and 26 is incorporated, and further, claims 13, 34, 42, 47, 50, 55, 58, 61, 64 and 73 recite substantially similar limitations from claims 1 and 26 and are therefore rejected under the same rationale.

Per claims 2, 14 and 15:

Article further discloses a custom database capable of storing a plurality of operating system provided compatibility fixes and said plurality of compatibility fixes are added to said list of compatibility fixes for said requested application (Note at least Figure 7 and the corresponding discussion.)

Per claims 3, 16, 59 and 62:

Article further discloses determining if a central database includes one identifying attribute of an incompatible application that matches one identifying attribute of said requested application, and if one identifying attribute of said incompatible application matches one identifying attribute of said requested application, determining if said central database includes information about a custom database for said incompatible application (“These technologies work by virtue of ‘matching information’—that is, the application-specific information that enables the operating system to identify applications...” on page 2. Further, note the Application Database files on pages 2 and 3, and further, “When matching information determines that the user is about to run an incompatible application, Windows XP can...invoke a compatibility fix...” on page 4.)

Per claims 4 and 17:

Article further discloses an executable name attribute (“include the file name...” on page 2)

Per claims 5, 18, 46, 54, 60 and 63:

Article further discloses if one identifying attribute of said incompatible application matches one identifying attribute of said requested application, and if said central database contains information about a custom database for said incompatible application, determining if said custom database for said incompatible application contains additional identifying attributes of said incompatible application that match additional identifying attributes of said requested application (“These technologies work by virtue of ‘matching information’—that is, the application-specific information that enables the operating system to identify applications...” on page 2. Further, note the Application Database files on pages 2 and 3, and further, “When matching information determines

that the user is about to run an incompatible application, Windows XP can...invoke a compatibility fix..." on page 4.)

Per claims 6 and 19:

Article further discloses identifying attributes including a size attribute, a version attribute, and a checksum attribute ("its size, a checksum of the file's contents, the file version..." on page 2)

Per claims 7, 9, 20 and 22:

Article further discloses determining if there is an operating system provided compatibility fix for said requested application, and if there is an operating system provided compatibility fix, adding said fix to said list of compatibility fixes for said requested application (Note at least Figure 7 and the corresponding discussion.)

Per claims 8, 10, 21, 23, 44 and 52:

Article further discloses determining if a central database includes identifying attributes of an incompatible application that match identifying attributes of said requested application, and if so, determining if said central database includes information about an operating system provided compatibility fix for said incompatible application ("These technologies work by virtue of 'matching information'—that is, the application-specific information that enables the operating system to identify applications..." on page 2. Further, note the Application Database files on pages 2 and 3, and further, "When matching information determines that the user is about to run an incompatible application, Windows XP can...invoke a compatibility fix..." on page 4.)

Per claims 11 and 12:

The rejection of claims 1-10 are incorporated, and further, claims 11 and 12 recite substantially similar limitations from claims 1-10 and are therefore rejected under the same rationale.

Per claims 24 and 25:

The rejection of claims 13-23 are incorporated, and further, claims 24 and 25 recite substantially similar limitations from claims 13-23 and are therefore rejected under the same rationale.

Per claims 27 and 35:

Article further discloses selecting a plurality of operating system provided compatibility fixes for said application and storing said plurality of selected operating system provided compatibility fixes in said custom database for said application (“creating and maintaining custom compatibility databases...add to or remove from your custom database any specific fixes...” on page 11)

Per claims 28, 36, 43 and 51:

Article further discloses storing identifying attributes of said application in a central database, and storing information about said custom database for said application in said central database (Note the Application Database files on pages 2 and 3, and further, “When matching information determines that the user is about to run an incompatible application, Windows XP can...invoke a compatibility fix...” on page 4.)

Per claims 29, 37, 45 and 53:

Article further discloses storing additional identifying attributes of said application in said custom database for said application (“application-specific information that enables the operating system to identify applications and act appropriately...Matching information...may include the file name, its size, a checksum of the file’s contents, the file version...” on page 2)

Per claims 30, 38 and 68:

Article further discloses generating identifying attributes for files (“application-specific information that enables the operating system to identify applications and act appropriately...Matching information...may include the file name, its size, a checksum of the file’s contents, the file version...” on page 2)

Per claims 31, 39, 70 and 72:

Article further discloses applying said selected operating system provided compatibility fixes and running said application in a test mode (“In the final portion of the wizard, you can test the compatibility settings you have selected”)

Per claims 32 and 33:

The rejection of claims 26-31 are incorporated, and further, claims 32 and 33 recite substantially similar limitations from claims 26-31 and are therefore rejected under the same rationale.

Per claims 40 and 41:

The rejection of claims 34-39 are incorporated, and further, claims 40 and 41 recite substantially similar limitations from claims 34-39 and are therefore rejected under the same rationale.

Per claims 48 and 49:

The rejection of claims 42-47 are incorporated, and further, claims 48 and 49 recite substantially similar limitations from claims 42-47 and are therefore rejected under the same rationale.

Per claims 56 and 57:

The rejection of claims 50-55 are incorporated, and further, claims 56 and 57 recite substantially similar limitations from claims 50-55 and are therefore rejected under the same rationale.

Per claim 65:

Article further discloses a user interface for use in association with creating said custom database for said application, wherein the user interface is displayed to a user and comprises one or more dialog boxes for requesting information about said incompatible application from the user (Note Figures 3-7 and the corresponding discussion.)

Per claim 66:

Article further discloses an option to browse for the path to the executable file for said incompatible application and upon selecting of said browse option, further browsing for the path of the executable file for said incompatible application that matches said information provided by the user (Note Figure 5, Browse option for the application to be fixed.)

Per claim 67:

Article further discloses a menu including a list of identifying attributes of said incompatible application, selecting one of said identifying attributes, and identifying said incompatible application using said selected identifying attribute (Note Figures 3-7 and the corresponding discussion.)

Per claims 69 and 71:

Article further discloses a menu including a list of operating system provided compatibility modes, and storing a set of compatibility fixes in said selected compatibility mode in said custom database for said incompatible application (Note Figures 5-7 and the corresponding discussion. Further, “Once you have added all the necessary compatibility fixes to your custom database, you can save the database...” on page 12.)

Per claims 74-79:

Article further discloses launching said application after the step of applying said compatibility fixes on said list to said requested application (“This applies the appropriate compatibility mode whenever the executable file is run”)

Response to Amendment and Request for Clarification

In response to the final Office Action of 24 February 2006, Applicants have filed an RCE with two separate exhibits, Exhibit A being a 131 declaration signed by one of the authors of the Article article, Exhibit B being a 132 declaration signed by the four listed inventors of the instant application. Applicants have further submitted comments requesting clarification of why the 132 declaration has been held as failing to overcome the 102(a) rejection in view of the Article by

Morehouse and Phillips. The Examiner presents the following comments in hopes of clearing some confusion.

Applicants make note on page 2 of the Request that it is their understanding that the 132, even when considered in combination with the previously submitted 131, "fails to establish:

- a. lack of derivation of the claimed invention by the inventors (i.e., the applicants) from the authors of the article that forms the basis for the 35 U.S.C § 102(a) rejection ("Article");
- b. that the invention was made by the inventors and not the authors of the Article;
- c. how information about the invention was transmitted from the inventors to the authors of the Article; and
- d. a correspondence or one-to-one mapping of at least one claim of the present application that corresponds to a screen shot illustrated in the Article." (Note page 2 of the Request)

Response:

As an initial matter, the Examiner notes that the issue of derivation would be not be the "lack of derivation of the claim invention by the inventors from the authors of the article" but rather the matter of derivation concerns the lack of statements disclosing derivation of the claimed invention **by the authors from the inventors.**

MPEP 716.10 outlines some requirements for showing attribution of a reference to an applicant. Additionally,

"As an initial matter, we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article . . . [o]n the other hand, when the PTO is aware of a printed publication,

which describes the subject matter of the claim invention and is published before an application is filed . . . the article may or may not raise a substantial question whether the applicant is the inventor. For example, if the author (whether he is the applicant or not) specifically states that he is describing the work of the application, no question at all is raised.”

In re Katz, 687 F.2d 450, 455 (Ct. Cust. App. 1982). However, in instances where the author or the article does not state anything specific about inventorship, it is incumbent upon the inventors to provide a satisfactory showing which would lead to a reasonable conclusion that applicants are the sole inventors. Id. “The specific question . . . is essentially an evidentiary one, namely, the sufficiency of applicant’s showing to establish that the subject disclosure was his original work, and his alone.” Id. The burden of proof is therefore on Applicants to establish that the authors of the Article derived the relevant subject matter from them. In re Carreira, 532 F.2d 1356, 1359 (Ct. Cust. App. 1976). The declarations must be specific such that nothing in the record precludes the possibility that the relevant subject matter was disclosed to the authors by some third party. Id. “[W]e will not make an inference in favor of a party carrying the burden of proof when, from the facts of record, other reasonable conclusions are possible.” Id.

Regarding item (i), Applicants argue that no issue of derivation exists, as one of the authors of the Article has clearly stated in the 131 declaration that neither he nor his co-author is the inventor of the technologies described in the Article. However, the Examiner notes the cited portions of Katz and Carreira above, and further, MPEP 715.01(c) which discloses that a patent or publication may be removed by submission of evidence establishing the fact that the “author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant **must further show that he or she made the invention upon which the relevant disclosure in the . . . other publication is based.**” (MPEP 715.01(c)) (emphasis added). The Examiner contends that there is an issue of derivation, as Applicants must show that they made the invention disclosed in

the Article, that the authors of the Article (Dave Morehouse and Todd Phillips) derived their knowledge from the inventors of the instant application, and that the information provided in the Article corresponds to the claimed invention.

Even taking the 131 and 132 declarations in combination, the declarations fail to state that Dave Morehouse and Todd Phillips specifically derived their knowledge from any of the four Applicants, rather, the 131 states that the information described in the Article was disclosed “by others at Microsoft Corporation.” (Exhibit A, pg 1.). The declaration does not set forth who these “others” are which were responsible for conveying information to Dave Morehouse and Todd Phillips, and thus does not prove that the subject matter was not disclosed to them by a third party rather than by the inventors of the instant invention. Furthermore, the 132 declaration does not include a statement by Applicants showing that they made the invention upon which the relevant disclosure of the Article is based and that the authors derived their knowledge from the inventors of the instant invention. Furthermore, it does not make a showing that Applicants’ made the invention upon which the Article is based, as the statement would emphasize that the Article is based on descriptions of Windows XP, includes details of Applicant’ invention, and was prepared at the request of Mark Carroll during the development of the Windows XP operating system. As such, these statements would not preclude the possibility that the relevant subject matter was disclosed to the authors by people other than the inventors of the instant invention.

Regarding item (ii), Applicants further submit that the 132 declaration states that the Article describes Applicants’ invention, not an invention of the authors of the Article, and that the clear and unequivocal statements by both the inventors and the authors of the Article leave no question regarding who invented the subject matter described in the Article. The Examiner notes MPEP

716.10 which states that “[a]n uncontradicted “unequivocal statement” from the application regarding the subject matter disclosed in an article . . . will be accepted as establishing inventorship . . . However, a statement by the applicants regarding their inventorship in view of an article . . . may not be sufficient where there is evidence to the contrary.” (MPEP 716.10) (emphasis added).

It is the Examiner’s position that the statements in the 132 declaration are not uncontradicted unequivocal statements to sufficiently establish inventorship of the instant application, as a number of the statements leave a question as to who should be listed as an inventor. Primarily, paragraph 4 of Exhibit B states that Dave Morehouse and Todd Phillips prepared the Article at the request of Mark Carroll, and that the acknowledgments section of the Article recognizes Mark Derbecker (one of the Applicants) “as well as Mark Carroll and other program and product managers . . .” (page 2, Exhibit B). If this statement is an intention to show that Mark Derbecker was responsible for the information pertaining to the aspects of the instant invention, this raises a question of whether subject matter in the Article should also be attributed to Mark Derbecker or to Mark Carroll and “other program and product managers” listed in the statement, along with the other three currently named inventors. Additionally, paragraphs 2 of Exhibit B states that the invention described and claimed was part of the development of Windows XP, and paragraph 3 states that the development of the Windows XP operating system “involved a large team of programmers, software developers, program managers . . .” (page 1, Exhibit B). The declaration does not describe who the members of this “large team” are, and further, by indicating that the instant application was part of the development of Windows XP, of which was developed by “a large team,” the Examiner is left with statements which show evidence to the contrary of paragraph 1 of sole inventorship of the instant application by Applicants, mainly, the statements set

forth that members of this large team could have been programmers and developers of the claimed invention instant application as well.

Regarding item (iii), Applicants' submit that paragraphs 2-4 of Exhibit B adequately describe how information about the invention was transmitted from Applicants to the authors of the Article. The Examiner contends that the paragraphs do not set forth this requirement. As noted above, Kroger sets forth a requirement of a showing of proof that the patent subject matter was not disclosed to the author(s) by a third person rather than by Applicants. The Examiner contends that paragraph 4 clearly sets forth that Dave Morehouse and Todd Phillips were directed to prepare the Article at the request of Mark Carroll, and none of the paragraphs provide any evidence or even mention that the authors (Morehouse or Phillips) received any information from the inventors of the instant invention. Thus the declaration fails to show derivation as required by MPEP 715.01(c).

Finally, regarding item (iv), the purpose of a correspondence between the claims of the instant application and the Article is to further prove that the Article is a derivative work of Applicants by establishing a link between Applicants' claimed invention and the information disclosed in the Article. Applicants fail to provide a correspondence between the screenshots in the article and their claimed invention, and it is noted that the Examiner relied upon the disclosure in addition to screenshots, thus it is incumbent upon Applicants to show how the screenshots correspond to the claimed invention in showing derivation of relevant knowledge from the inventors to the authors of the Article.

For these reasons, the 131 and 132 declarations are held to be insufficient for obviating the rejection in view of the Article.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trenton J Roche
Examiner
Art Unit 2193

Trenton J. Roche
TRENTON J. ROCHE
EXAMINER
SUPERVISORY EXAMINER
2001

TJR